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In re Application of  
Shannon Morris  
Application No. 10/004,511  
Filed: October 22, 2001  
Atty Docket No. OSSV-083441

DECISION ON PETITION

This is a decision on the petition filed on February 23, 2004, by which requests that prosecution on the merits of this application be reopened. The petition is being considered under 37 CFR 1.181, and no fee is required. Therefore, a refund of the \$130.00 petition fee tendered with the petition will be scheduled.

The petition is granted.

Petitioner is requesting that prosecution be reopened in this application following an Examiner's Answer because the Examiner's Answer is alleged to contain a new ground of rejection. A review of the record shows that petitioner is correct in pointing out that the Examiner's Answer clearly contains a new rationale in support of the rejection of claim 8. While MPEP § 1208.01 indicates a change in the rationale in support of or the discussion of does not necessarily amount to a new ground of rejection where the evidence relied upon and the statutory basis for the rejection remain unchanged, a review of the record shows that in this instance, the rationale for the rejection is so different than that previously relied upon in the final rejection, as to constitute a new ground of rejection. Petitioner is correct in noting that in this instance, the newly advanced rationale for the rejection might be easily overcome by simply amending the claim, thereby avoiding the appeal process. Petitioner does not enjoy that option as a matter of right, and does not have the amount of time to consider that option that reopening the prosecution would provide if petitioner does not have the amount of time to make that decision that would be available if prosecution is reopened.

37 CFR 1.193(a)(2) prohibits the introduction of a new ground of rejection in an Examiner's Answer. See also MPEP § 1208.01. As it has been determined that the Examiner's Answer of record contains a new ground of rejection, the examiner is instructed to withdraw the Examiner's Answer in favor of reopening prosecution. The application is being remanded to the Supervisory Patent Examiner in Art Unit 3728 for action not inconsistent with this decision.

PETITION GRANTED.

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